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| APPLICATION NO.   | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|---|-------------|----------------------|---------------------|------------------|
| 09/518,787  | 03/03/2000  | Kurt Clement         | 108298627US         | 7353             |
| 25096   | 7590        | 02/10/2004           | EXAMINER            |                  |
| PERKINS COIE LLP<br>PATENT-SEA<br>P.O. BOX 1247<br>SEATTLE, WA 98111-1247 |             |                      | REAGAN, JAMES A     |                  |
|   |             |                      | ART UNIT            | PAPER NUMBER     |
|   |             |                      | 3621                |                  |

DATE MAILED: 02/10/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

|                              |                        |                     |
|------------------------------|------------------------|---------------------|
| <b>Office Action Summary</b> | <b>Application No.</b> | <b>Applicant(s)</b> |
|                              | 09/518,787             | CLEMENT, KURT       |
|                              | <b>Examiner</b>        | <b>Art Unit</b>     |
|                              | James A. Reagan        | 3621                |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 28 November 2003.
- 2a) This action is FINAL.                    2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-29 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) 1-29 is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All    b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |   |   |
|---|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)  | 4) <input type="checkbox"/> Interview Summary (PTO-413)                     |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)                                    | Paper No(s)/Mail Date. _____  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)<br>Paper No(s)/Mail Date _____. | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
|   | 6) <input type="checkbox"/> Other: _____.                                   |

**DETAILED ACTION****Status of Claims**

1. This action is in reply to the response received on 28 November 2003 (paper #13).
2. Claims 1-29 have been examined.
3. The rejections of claims 1-29 are unchanged.

**RESPONSE TO ARGUMENTS**

4. Applicant's arguments received on 28 November 2003 have been fully considered but they are not persuasive. Referring to the previous Office action, Examiner has cited relevant portions of the references as a means to illustrate the systems as taught by the prior art. As a means of providing further clarification as to what is taught by the references used in the first Office action, Examiner has expanded the teachings for comprehensibility while maintaining the same grounds of rejection of the claims, except as noted above in the section labeled "Status of Claims." This information is intended to assist in illuminating the teachings of the references while providing evidence that establishes further support for the rejections of the claims.
5. Applicant's arguments with respect to claims have been considered but are moot in view of the new ground(s) of rejection. However, in an effort to elucidate the applicability of the selected prior art, the Examiner has provided a riposte to the Applicant's arguments.

6. With regard to the limitations of claims 1, 10, and 21, Applicant argues that the combination of Wyman and Applicant's own admission to not disclose the limitation of recording authorization in the computer system. The Examiner respectfully disagrees, and points to the background section of the application, page three, wherein Applicant has reference to America Online (AOL). In addition, Wyman, in column 23, lines 11 - 37 discloses storing an authorization handle to grant access to data. Although Wyman does not specifically disclose an authorization per se recorded on the user's hard drive, one of ordinary skill in the art which conclude that it is an obvious modification to store authorization data on a hard drive in light of AOL's technique of pre loading software onto a computer before the computer shipped to user and Wyman's use of storing an authorization handle on the computer's hard drive. It would be of little burden or consequence to the public to modify these techniques to store a complete authorization on a user's computer.

7. The following is a **Final Rejection** of all claims and associated limitations pending in the current application as amended in paper #7.

#### **Claim Rejections - 35 USC § 103**

8. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would

have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

9. Claims 1-29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Wyman (US 5,438,508) in view of Applicant's own admission.

**Examiner's note:** Examiner has pointed out particular references contained in the prior art of record in the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the *entire* reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the examiner.

**Claims 1, 10, and 21:**

With regard to the limitations of:

- *controlling access to the data through computer executable code that requires authorization for continued access to the data by automatically:*
- *detecting access to the data by the user, and*
- *querying the user's account, and if permission to continued access is verified, then enabling continued access to the data.*

Wyman, in column 1, lines 36-38 discloses, "...usage of licensed software may be monitored in a computer system to determine if a use is within the scope of a license", and product use authorizations (abstract).

Wyman does not specifically disclose:

- *recording data on a fixed medium in the computer system; and*
- *providing for transfer of the computer system to the user.*

However, Examiner takes **Official Notice** that it is old and well known in the computer arts to sell computers with software already installed on the machine's hard disk. The Windows operating system, various third-party applications, and online services such as America Online, Prodigy, and MSN are all preinstalled on a computer when it comes from the factory to the new owner. In addition, Wyman discloses, "Each licensed product upon start-up makes a call to a license server to check on whether usage is permitted, and the license server checks a database of the licenses, called product use authorizations, that it administers," inherently disclosing recordation of access privileges.

With regard to the limitations of granting access to data after contacting the a party, recording the authorization, and granting a second access to the data based on the recorded authorization, Wyman discloses a database interface and a log function, and a management interface which directs the access of the user (column 11, lines 36-58). It would be obvious to one of ordinary skill in the art at the time of the invention to grant repeated access to the data if the user is authorized. Wyman also discloses different types of licenses, which inherently disclose repeated access to the data (column 20, lines 13-53). It would have been obvious to one of ordinary skill in the art at the time of the invention to provide multiple and repeated access to data because this provides and efficient

and cost-effective means for distributing applications and data to individual and group users.

With regard to the newly added limitations of recording authorizations within the user computer system, Wyman in column 23, lines 11-37 discloses storing the authorization handle on the client computer for future reference.

**Claim 2:**

With regard to the limitation of *the act of recording data on the fixed medium includes recording software application program instructions on the fixed medium*, Examiner takes **Official Notice** that it is old and well known in the computer arts to install on the hard drive self-executing programs that automatically install an application when activated. AOL routinely places a shortcut onto the desktop of a new computer wherein a new user can click on the shortcut and the application will install the browser software and automatically connect to the Internet to begin setting up an account.

**Claims 3, 11, and 22:**

With regard to the limitation of *recording software application program instructions on the fixed medium includes recording software application program instructions that enable a software application that does not depend on continued access to a network for fully functional operation*, Wyman, in column 2, lines 42-44 discloses a spreadsheet program.

**Claims 4-9 and 12:**

With regard to the limitations of:

- *the act of recording data on the fixed medium includes recording data on a hard disk drive.*
- *the act of controlling access to the data includes the computer system automatically executing computer readable instructions to contact a party authorized to grant access to the data.*
- *executing computer readable instructions includes executing instructions to activate a network link.*
- *executing computer readable instructions includes executing instructions to activate access to the Internet.*
- *the act of controlling access to the data includes determining if a user has a sufficient account credit to continue access to the data.*
- *the act of controlling access to the data includes determining if a user should be billed for accessing the data.*

Examiner takes **Official Notice** that it is old and well known in the computer arts to install a self-extracting, self-executing program onto the hard drive of a computer, automatically dial up an ISP after installation, access the Internet, verify available credits (free hours) according to a sponsored program, and set up a billing account with a user's credit card. Applicant has referenced AOL in the section of the specification marked "Background of the Invention",

and, as one of ordinary skill in the art would agree, AOL anticipates these steps when providing Internet access to a new customer for the first time.

**Claims 13 and 23:**

With regard to the limitation of *verifying authority to access the software application verifies authority of a particular user to access the software application*, Wyman, in column 1, lines 36-38 discloses, "...usage of licensed software may be monitored in a computer system to determine if a use is within the scope of a license."

**Claims 14 and 24:**

With regard to the limitation of *verifying authority to access the software application verifies authority of an accessing computer system to access the software application*, Wyman discloses distributing software licenses among the units of an organization (column 2, lines 22-40).

**Claims 15-20 and 25-29:**

With regard to the limitations of:

- *verifying authority to access the software application is accomplished through a network connection.*
- *verifying authority to access the software application is accomplished through an Internet interface.*
- *if authority is not verified, then interrupting access to the software application.*

- *if authority to access the software application is not verified, then the user is presented with an opportunity to qualify for access to the software application.*
- *the opportunity to qualify for access to the software application includes generating a request to set up an account.*
- *if authority to access the software application is not verified, then the user's access to the software application is terminated.*

Examiner takes **Official Notice** that it is old and well known in the computer arts to check a password or authorization code across an Internet connection using a web browser, denying access if the code is incorrect, applying for an account, and terminating the session if an account is not requested or granted. Applicant has referenced AOL in the section of the specification marked "Background of the Invention", and, as one of ordinary skill in the art would agree, AOL anticipates these steps when providing Internet access to a new customer for the first time.

### **Conclusion**

- 10. THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).
- 11.** A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to **James A. Reagan** whose telephone number is **(703) 306-9131**. The examiner can normally be reached on Monday-Friday, 9:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, **James Trammell** can be reached at **(703) 305-9768**.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the **Receptionist** whose telephone number is **(703) 305-3900**.

Any response to this action should be mailed to:

**Commissioner of Patents and Trademarks**

**Washington, D.C. 20231**

or faxed to:

**(703) 305-7687** [Official communications; including

After Final communications labeled "Box AF"]

**(703) 308-1396** [Informal/Draft communications, labeled  
"PROPOSED" or "DRAFT"]

Hand delivered responses should be brought to Crystal Park 5, 2451  
Crystal Drive, Arlington, VA, 7<sup>th</sup> floor receptionist.

JAR  
04 February 2003

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